

### REMARKS

In response to the non-final Office Action of November 14, 2007, applicants ask that all claims be allowed in view of the amendment to the claims and the following remarks. Claims 1, 3-27, and 29-56 are pending in the application, with claims 1, 26, 27, and 52 being independent.

#### **Interview Request**

Applicants respectfully request an interview with the Examiner prior to the substantive examination of this Reply. To that end, applicants' representative will be contacting the Examiner shortly to schedule an interview. However, to the extent that an interview has not been scheduled prior to the substantive examination of this Reply, applicants respectfully request the Examiner to treat the foregoing as a formal interview request and ask that the Examiner call the undersigned at (202) 783-5070 to schedule an interview.

#### **Claim Rejections Under 35 U.S.C. § 101**

Claims 27 and 29-52 have been rejected under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter. In particular, the Office Action indicates that "[c]laims 27 and 29-52 recite a computer program stored on a computer readable medium" and that "the specification states that the computer readable medium comprises a propagated signal . . . , which is non-statutory according to MPEP 2106." Office Action of November 14, 2007 at page 2, lines 17-20.

As an initial matter, applicants note that claims 27 and 29-52 recite a computer program stored on a tangible computer readable medium, not simply a computer program stored on a computer readable medium, as asserted by the Office Action. Moreover, applicants note that, in response to a similar rejection under 35 U.S.C. § 101, applicants amended claims 27 and 29-52 in applicants' June 13, 2007 Amendment to specify that the recited computer programs are stored on tangible computer readable media and that the rejection of claims 27 and 29-52 under 35 U.S.C. § 101 was withdrawn. Accordingly, applicants request reconsideration and withdrawal of the rejection of claims 27 and 29-52 for the same reasons that the rejection

originally was withdrawn, namely that claims 27 and 29-52 specify that the recited computer programs are stored on tangible computer readable media.

#### **Claim Rejections Under 35 U.S.C. § 102**

Claims 1, 3-6, 8-11, 19-21, 26, 27, 29-32, 34-37, 45-47, and 52-56 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0212804 (Hashemi). Applicants have amended independent claims 1, 26, 27, and 52 and request reconsideration and withdrawal of the rejection of claims 1, 3-6, 8-11, 19-21, 26, 27, 29-32, 34-37, 45-47, and 52-56 because Hashemi fails to describe or suggest all of the features recited in amended independent claims 1, 26, 27, and 52.

#### **Claims 1, 3-6, 8-11, 19-21, 27, 29-32, 34-37, 45-47, and 53-56**

Independent claim 1 recites a computer implemented method for sending a video clip in an instant messaging communications session that has been established between an instant message sender using a client computer and an instant message recipient using another client computer. As amended, independent claim 1 recites, among other features, storing a collection of video clips on a host system that is separate from both the client computer of the instant message sender and the client computer of the instant message recipient. In addition, independent claim 1 recites receiving, at the host system, a request from the instant message sender's client computer for a particular video clip stored on the host system to be delivered to the instant message recipient's client computer within the instant messaging communications session, and communicating the particular video clip from the host system to the instant message recipient's client computer within the instant messaging communications session for rendering.

Hashemi describes a peer-to-peer media clip sharing system that enables users to share pre-recorded media clips without actually transferring the file(s) in which the media clips are stored. See Hashemi at Abstract. As described by Hashemi, members of a peer group may use the media clip sharing system to designate certain media clips stored on local computers as media clips to be shared with (i.e., made available to) other members of the peer group. See,

e.g., Hashemi at paragraphs [0021]-[0027] and [0038]-[0049]. Individual members of the peer group then may use the media clip sharing system to access the media clips that are stored on the local computers of other members of the peer group and that have been designated as shared by the other members of the peer group. See, e.g., Hashemi at paragraphs [0021]-[0027] and [0038]-[0049].

In particular, Hashemi describes presenting a user interface to a user that includes, among other features, a media clip browse window that indicates various media clips that are stored on the local computers of other members of the user's peer group and that have been made available to the user by the other members of the user's peer group. See, e.g., Hashemi at paragraphs [0021]-[0027] and [0038]-[0049]. In response to the user selecting a particular one of the media clips listed in the media clip browse window, the selected media clip is streamed to the user from the local computer of the member of the peer group that made the media clip available to the user. See, e.g., Hashemi at paragraphs [0021]-[0027] and [0038]-[0061].

Importantly, Hashemi describes that media clips are stored on the local computers of the members of the peer group and that media clips are streamed directly from the local computers of members of the peer group to the local computers of other members of the peer group. Consequently, Hashemi fails to describe or suggest storing a collection of video clips on a host system that is separate from both a client computer of an instant message sender and a client computer of an instant message recipient, and communicating a particular video clip from the host system to the instant message recipient's client computer within the instant messaging communications session for rendering, as recited in independent claim 1.

Hashemi does teach that lists of available media clips may be stored on a central server:

[0058] In one embodiment, a user computer retrieves the list [of media clips] directly from the peer computer. In another embodiment, the list of media clips may advantageously be exchanged through the central server 102, which can also be configured to store the list of media clips. One embodiment of the process further arranges the list of media clips into media clips that may advantageously be freely available to a peer and to media clips that require an additional authorization step, such as authorization through a password or through a pop-up window.

For example, where a media clip requires an additional authorization step, the title of the media clip can be emphasized by shading and the like. The process advances from the seventh block 370 to an eighth block 380.

Hashemi at paragraph [0058] (emphasis added). However, while Hashemi describes that a list of available media clips may be stored on central server, Hashemi does not describe that the media clips themselves are stored on the central server. Rather, as discussed above, the media clips are stored on the local computers of the members of the peer group.

Therefore, Hashemi fails to describe or suggest storing a collection of video clips on a host system that is separate from both a client computer of an instant message sender and a client computer of an instant message recipient, and communicating a particular video clip from the host system to the instant message recipient's client computer within the instant messaging communications session for rendering, as recited in independent claim 1.

Accordingly, for at least the foregoing reasons, applicants request reconsideration and withdrawal of the rejection of independent claim 1 and its dependent claims, claims 3-6, 8-11, 19-21, 53, and 54.

Independent claim 27 recites features similar to those discussed above in connection with independent claim 1 and does so in the context of a computer program stored on a tangible computer readable medium. Therefore, for at least the reasons discussed above in connection with independent claim 1, applicants request reconsideration and withdrawal of the rejection of independent claim 27 and its dependent claims, claims 29-32, 34-37, 45-47, 55, and 56.

#### Claims 26 and 52

With respect to independent claim 26, the Office Action asserts only that "[c]laim 26 recites a method with substantially the same limitations as the method of claim 1. Therefore, the claims are rejected under the same rationale." Office Action of November 14, 2007 at page 7, lines 12-13. As an initial matter, applicants note that the subject matter recited in independent claim 26 differs from the subject matter recited in independent claim 1.

Independent claim 26 recites a computer implemented method for enabling perception of a video clip in an instant messaging communications session. As amended, independent claim 26 recites, among other features, receiving, within an instant messaging communications session involving an instant message recipient and an instant message sender, a text instant message that includes a selectable link that corresponds to a selected video clip to be displayed to the instant message recipient by the instant messaging recipient system within the instant messaging application user interface, the video clip having been selected by the instant message sender as a video clip to be sent to the instant message recipient in the instant messaging communications session. Hashemi does not describe or suggest this feature of independent claim 26. Accordingly, for at least this reason, applicants request reconsideration and withdrawal of the rejection of independent claim 26.

As amended, independent claim 52 recites features similar to those discussed above in connection with independent claim 26 and does so in the context of a computer program stored on a tangible computer readable medium. Therefore, for at least the reasons discussed above in connection with independent claim 26, applicants request reconsideration and withdrawal of the rejection of independent claim 52.

### **Claim Rejections Under 35 U.S.C. § 103**

#### Claims 7 and 33

Claims 7 and 33, which depend from independent claims 1 and 27 respectively, have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashemi in view of U.S. Patent No. 5,919,247 (Van Hoff). However, Van Hoff does not cure the deficiencies in Hashemi noted above, nor does the Office Action contend that Van Hoff does so. Accordingly, applicants request reconsideration and withdrawal of the rejection of claims 7 and 33 at least because of their dependencies and the reasons discussed above in connection with independent claims 1 and 27.

#### Claims 12-15 and 38-41

Claims 12-15 and 38-41, each of which depends from one of independent claims 1 and 27, have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashemi in view of U.S. Patent No. 6,070,171 (Snyder). However, Snyder does not cure the deficiencies in Hashemi noted above in connection with independent claims 1 and 27, nor does the Office Action contend that Snyder does so. Accordingly, applicants request reconsideration and withdrawal of the rejection of claims 12-15 and 38-41 at least because of their dependencies and the reasons discussed above in connection with independent claims 1 and 27.

#### Claims 16-18 and 42-44

Claims 16-18 and 42-44 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashemi in view of U.S. Patent Application Publication No. 2003/0236835 (Levi). However, Levi does not cure the deficiencies in Hashemi noted above in connection with independent claims 1 and 27, nor does the Office Action contend that Levi does so. Accordingly, applicants request reconsideration and withdrawal of the rejection of claims 16-18 and 42-44 at least because of their dependencies and the reasons discussed above in connection with independent claims 1 and 27.

#### Claims 22-25 and 48-51

Claims 22-25 and 48-51, each of which depends from one of independent claims 1 and 27, have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashemi in view of Yubing Wang et al., Video: An Empirical Study of RealVideo Performance Across the Internet (Wang). However, Wang does not cure the deficiencies in Hashemi noted above in connection with independent claims 1 and 27, nor does the Office Action contend that Wang does so. Accordingly, applicants request reconsideration and withdrawal of the rejection of claims 22-25 and 48-51 at least because of their dependencies and the reasons discussed above in connection with independent claims 1 and 27.

## Conclusion

Applicants submit that all claims are in condition for allowance.

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, issue, or comment does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this reply should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this reply, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

The fee in the amount of \$120 in Payment of the Petition for One-month Extension of Time is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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